

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

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UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 31 2002

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT R. WATTERSON and WILLIAM T. DALEBOUT

Appeal No. 2002-0917
Application No. 08/942,810

ON BRIEF

Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-37, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a treadmill having a vertically extending support structure, a tread base that may be reoriented from a first or exercise position to a second or upright storage position and a gas spring connected between the support structure and the tread base for assisting a user in rotating the tread base between the operating position and the storage position. Claim 21 is illustrative of the invention and reads as follows:

21. A treadmill comprising:

 a support structure;

 a tread base rotatably attached to the support structure such that the tread base is selectively moveable between an operating position and a storage position; and

 a gas spring connected between the support structure and the tread base.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Schönenberger	4,026,545	May 31, 1977
Teague, Jr. (Teague)	4,370,766	Feb. 1, 1983
Rorabaugh	4,664,646	May 12, 1987
Wilkinson et al. (Wilkinson)	5,207,622	May 4, 1993

The following rejections are before us for review.

(1) Claims 21-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rorabaugh in view of Teague.

(2) Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rorabaugh in view of Teague and Schönenberger.

(3) Claims 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rorabaugh in view of Teague and Wilkinson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 17 and 24) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 23) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants (brief, page 8) state that claims 21-24 and 31-34 stand or fall together and that claims 25-30 are separately patentable therefrom. The sole basis for appellants' separate grouping of claims 25-30, however, is that claim 25 recites a means-plus-function limitation ("lift assist means ... for assisting...") whose scope must be determined from the specification in accordance with 35 U.S.C. § 112, sixth paragraph (brief, page 8), whereas claims 21 and 31 recite a "gas spring," which is not

a means-plus-function limitation. With respect to all of claims 21-34, appellants' argument (brief, pages 10-14) is that the applied references would not have suggested the modification proposed by the examiner. Appellants have not argued, with respect to any of these claims, that, even if the modification were made, the claimed invention would not result or offered any other argument as to why claims 25-30 are separately patentable from claims 21-24 and 31-34. As set forth in 37 CFR § 1.192(c)(7), "[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." Thus, in accordance with 37 CFR § 1.192(c)(7), we have selected claim 21 as the representative claim to decide the appeal of rejection (1), with claims 22-34 standing or falling therewith. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Likewise, in accordance with 37 CFR § 1.192(c)(7), we have selected claim 36 as the representative claim to decide the appeal of rejection (3), with claim 37, which appellants have grouped therewith (brief, page 8), standing or falling therewith.

Turning first to rejection (1), Rorabaugh, the jumping off point of the examiner's obviousness determination, discloses a folding treadmill comprising a support structure (cabinet 37) and a tread base (treadmill frame 36, treadmill 13, etc.) rotatably attached to the support structure for selective movement between an operating position (Figure 2) and a storage position. As acknowledged by the examiner (final rejection, page 2),

Rorabaugh lacks a gas spring connected between the support structure and the tread base as called for in claim 21. To overcome this deficiency, however, the examiner relies upon the teachings of Teague of providing a counterbalancing mechanism (note lever 50, link 62, etc. in Figure 3) and a pair of gas springs 56 on a folding bed movable between an open position and a closed position stored within a cabinet 9, the gas springs providing the lifting force or moment to move the bed from its open position to the position where its center of gravity 61 passes over the pivot axis 13 and, when the bed continues to move toward the fully closed position, the springs continuing to exert an expanding force opposing the force of gravity to act against that continued movement. Likewise, when the bed is moved from its fully closed position toward the open position, the springs expand and aid in moving the bed from its fully closed position to the position where its center of gravity is above the pivot axis 13 (column 2, lines 3-14). According to the examiner, it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide a gas spring between the support structure (cabinet 37) and tread base (treadmill 13, treadmill frame 36, etc.) to provide an assist in moving the support structure into a storage position (final rejection, page 3). For the reasons which follow, we agree with the examiner.

Appellants argue (brief, pages 12-13) that Rorabaugh makes no mention of the need for a gas spring connected between the support structure and the tread base to assist in rotating the tread base between the operating position and the storage position

and that Teague, likewise, makes no reference to the need or desirability of applying the counterbalance mechanism disclosed therein to any other application or field of art. Thus, according to appellants, the applied references provide no teaching or suggestion to make the modification proposed by the examiner.

It is well established that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it

fairly teaches one of ordinary skill in the art, including the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

We recognize that Teague is directed to a foldable bed, not a treadmill, and thus may not be considered to be within appellants' field of endeavor. Nevertheless, a reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). In the present instance, one of the problems facing appellants (specification, pages 25-26) was the need for a lift assistance assembly to provide a force or torque urging the tread base from a first exercise position toward a second storage position. Teague teaches a lift assist assembly for providing a lift force to assist a user in folding a foldable structure (a bed) from a lowered horizontal position, against the force of gravity, to a vertical storage position and logically would have commended itself to an artisan's attention in considering appellants' problem. Thus, we conclude that Teague is analogous art with respect to appellants' invention. Assuming, as we must, that one of ordinary skill in the field of appellants' invention had knowledge of the teachings of Teague, such a person would have appreciated that the rotation of the treadmill 13 and treadmill frame 36 of

Rorabaugh from the horizontal exercise position to the vertical storage position would require application of significant lift force to oppose gravity and would have recognized the self-evident advantages of providing a lift assist assembly, including a gas spring exerting a lift force opposing gravity as taught by Teague, on the foldable treadmill of Rorabaugh to assist the user in applying such lift force.¹

For the foregoing reasons, we conclude that the combined teachings of Rorabaugh and Teague are sufficient to have suggested the subject matter of claim 21. Thus, we affirm the examiner's decision to reject claim 21, as well as claims 22-34 which fall with claim 21, as discussed above.

As for rejections (2) and (3), appellants do not contest the examiner's determination that the additional modifications of Rorabaugh to provide a latch, as taught by Schönenberger, and an inclination means, as taught by Wilkinson, would have been obvious to one of ordinary skill in the art at the time of appellants' invention. Rather, appellants' only arguments with respect to these rejections is that neither Schönenberger nor Wilkinson would have suggested providing a gas spring for lift assist, as required in each of the independent claims on appeal, and thus does not overcome the perceived deficiency of the combination of Rorabaugh and Teague discussed above. In light of our discussion above, it should be apparent that we do not

¹ To conclude otherwise would be to improperly assume that the artisan possesses less than ordinary skill. Sovish, 769 F.2d at 743, 226 USPQ at 774.

find these arguments persuasive with regard to rejections (2) and (3). It follows that we shall also affirm the decision of the examiner to reject claim 35 as being unpatentable over Rorabaugh in view of Teague and Schönenberger and to reject claim 36, as well as claim 37 which falls therewith, as being unpatentable over Rorabaugh in view of Teague and Wilkinson.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21-37 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED



NEAL E. ABRAMS
Administrative Patent Judge

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